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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,015	01/22/2002	John H. Dunlap	11388-003	5470
43935	7590	08/24/2005	EXAMINER	
FRASER MARTIN BUCHANAN MILLER LLC			SHAND, ROBERTA A	
132C WEST SECOND STREET			ART UNIT	
PERRYSBURG, OH 43551-1401			PAPER NUMBER	
			2665	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,015

Applicant(s)

DUNLAP, JOHN H.

Examiner

Roberta A. Shand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/7/02 7/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the network interface" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8, 11-17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Curry (U.S. 6233234 B1).

3. Regarding claim 1, Curry teaches (fig. 1) a telephone gateway device for selectively routing telephone calls between a PSTN and a computer network, comprising: a first telephone port adapted to connect to at least one POTS device (col. 3, lines 3-18 and fig. 9); a second telephone port (20) adapted to connect to a standard telephone jack connected to the PSTN; a modem (54) adapted to establish a dial-up connection to the computer network; a network

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interface device (58) adapted to establish a broadband connection to the computer network; a CODEC for encoding and decoding voice data relating to the telephone calls (col. 11, line 16 – col. 12, line 14); an internet telephony protocol for controlling internet telephone sessions on the computer network (col. 5, lines 1-10); a detection circuit (116) including a microprocessor for detecting an initiating of a call on an attached POTS device (fig. 9) and selectively routing the toll call to the computer network via the modem (54) or the network interface device (58).

4. Regarding claim 2, Curry teaches (fig. 3) the telephone gateway device comprising computer memory.

5. Regarding claim 3, Curry teaches (figs. 3 and 4 and col. 1) the computer memory is ROM.

6. Regarding claims 4 and 12, Curry teaches (col. 15, lines 34-50) the computer memory contains a unique identifier of the gateway.

7. Regarding claims 5 and 13, Curry teaches (figs. 3 and 4 and col. 1) the computer memory further comprises RAM to receive and store information related to a user and gateway.

8. Regarding claims 6 and 16, Curry teaches (col. 15, lines 13-33) detect a toll call based upon the dialing of a “1” or “011” on an attached POTS device. Curry teaches decoding DTMF dialing signals which reads on this limitation.

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9. Regarding claims 7 and 17, Curry teaches (fig. 5) the network interface comprises an Ethernet network interface card.

10. Regarding claims 8, 14 and 19, Curry teaches (fig. 7) a database of information relating to non-toll area codes relative to an area code of a phone number associated with the POTS device.

11. Regarding claim 11, Curry teaches (fig. 1) a telephone gateway device for selectively routing telephone calls between a PSTN and a computer network, comprising: a first telephone port adapted to connect to at least one POTS device (col. 3, lines 3-18 and fig. 9); a second telephone port (20) adapted to connect to a standard telephone jack connected to the PSTN; a modem (54) adapted to establish a dial-up connection to the computer network; a network interface (58) adapted to establish a broadband connection to the computer network; means for transmitting and receiving voice data over the computer network (fig. 5); and circuitry (116) adapted to selectively routing a toll call initiated on an attached POTS device (fig. 9) to the computer network via either the modem (54) or the network interface (58).

12. Regarding claim 15, Curry teaches (fig. 1) a telephone gateway device for selectively routing telephone calls between a PSTN and a computer network, comprising: a first telephone port adapted to connect to at least one POTS device (col. 3, lines 3-18 and fig. 9); a second telephone port (20) adapted to connect to a standard telephone jack connected to the PSTN; a modem (54) adapted to establish a dial-up connection to the computer network; a network

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interface (58) adapted to establish a broadband connection to the computer network; an internet telephony protocol (abstract); computer memory figs. 3 and 4 and col. 1 containing a unique identifier of the gateway device (col. 9, line 5, col. 10, line 9) to receive and store information relating to user of the gateway device; and circuitry (116) to detect a toll call placed on the POTS device and selectively route the toll call to the computer network via either the modem (54) or the network interface (58).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curry in view of Nagao (U.S. 5764278).

15. As mentioned above, Curry teaches all of the limitations of claim 1.

16. Curry does not teach ITU-T G.711, G.723, G.728, and G.729.

17. Nagao teaches (col. 5, lines 1-10) CODEC operating in accordance with ITU G.711, G.723, G.728, and G.729. It would have been obvious to one of ordinary skill in the art to adapt this to Curry's system, as it is well known in the art of audio encoding and decoding.

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18. Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curry in view of Schuster (U.S. 6577622 B1)).

19. As mentioned above, Curry teaches all of the limitations of claim 1.

20. Curry does not teach ITU-T H.323, SIP, and MGCP.

21. Schuster teaches (col. 8, lines 20-26)

22. It would have been obvious to one of ordinary skill in the art to adapt this to Curry's system, as it is well known in the art.

Response to Arguments

1. Applicant argues that the examples given in the Restriction Requirement were insufficient. Below is a more detailed explanation of reasons for restriction.

2. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

3. **In the instant case, invention I has separate utility such as to facilitating a telephone connection over a computer network based detecting an initiation of a toll call on an attached POTS device and selectively routing the call to a computer network via either a modem or a network interface, which is distinct from inventions II and III.**

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4. In the instant case, invention III has separate utility such as selectively routing a call over a computer network by comparing the area code to a database and routing based on toll or non-toll calls, which is distinct from inventions I and II.

5. In the instant case, invention II has separate utility such as facilitating a telephone connection over a computer network based on querying a database of ITSP's and selecting an ITSP based on the querying, which is distinct from inventions I and III.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and is not required for Group III, restriction for examination purposes as indicated is proper.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta A Shand whose telephone number is 571-272-3161. The examiner can normally be reached on M-F 9:00am-5:30pm.
4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roberta A Shand
Examiner
Art Unit 2665



STEVEN NGUYEN
PRIMARY EXAMINER